

**REMARKS/ARGUMENTS**

In the Office Action, the Examiner maintained the prior rejection of claims 1 - 10 under 35 USC 103 as being unpatentable over Cohen in view of Lien et al. The Examiner also maintained the prior rejection of claims 6 - 10 under 35 USC 103 as being unpatentable over Cohen in view of Lee et al. In maintaining these rejections, the Examiner indicated that it would be obvious to one of ordinary skill in the art to take the method of Cohen and modify the liquid compositions to those taught by Lien et al or Lee et al because Cohen teaches the requirements for a material to be a suitable conformable contact mask and the material taught by Lien et al. and Lee et al. meets those criteria.

In maintaining these rejections, the Examiner indicated that he recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this regard, the Examiner indicated that Cohen teaches a method of forming a conformable mask which comprises laser ablating a selected portion of material using UV radiation and that Cohen provides criteria for the material. The Examiner also indicates that Lien et al. and Lee et al. each individually disclose material meeting the limitations of the claimed material and provide descriptions of the properties and advantages of these materials. These assertions by the Examiner are inadequate to provide a prima facie case of obviousness. Does Cohen teach how to modify a silicone backboned material to make it adequately ablatable for forming a mask? Does Lien or Lee teach that their materials are adequately ablatable?

Neither Lien et al. nor Lee et al. disclose a material meeting all of the limitations of the claimed material and as teachings of Cohen do not address the shortcomings of Lien and Lee, no reasonable combination of Cohen and Lien or Cohen and Lee provides the invention as claimed. The materials of Lee or Lien are not taught as being laser ablatable and thus the materials of Lee and Lien do not meet all requirements of the claimed material. Cohen does not teach us to expect that they would be. Neither does Cohen teach how to modify a silicone backboned material to make it adequately ablatable. As such there is absolutely no motivation to one of ordinary skill in the art to make the required combination. If Applicant is mistaken in this assertion the Examiner is asked to unambiguously point out where the teachings are in Lien or Lee and/or how Cohen that clearly indicate that materials of the type taught by Lien and Lee will be UV laser radiation ablatable.

Applicant recognizes that some reasonable combinations of Cohen and Lien or Lee are potentially possible and could make obvious certain potential inventions. However, as there are

potentially dozens or hundreds of potential combinations of Cohen with Lien and/or Cohen with Lee and as there is no particular reason to select the required combination (even it exists), it must be concluded that no reasonable combination can make obvious the invention as claimed. For example, many potential material and process combinations of Cohen and Lee or Cohen and Lien may be directed to silicone based masks that are formed without ablation. Reconsideration of the rejections is earnestly solicited in view of the above clarifications.

Applicant further recognizes that if Lien or Lee were being applied against the novelty of the claims, then properties inherent to the materials taught therein would be relevant. But when the references do not set forth that their materials possess a critical property, it seems incredible to think one of ordinary skill in the art would select such a material for use in a distinct process for which there is no reasonable basis to believe it will be applicable. This is particularly true in view of the fact that hundreds or thousands such materials of unknown applicability exist. In fact if one simply goes out and starts experimenting with numerous materials of unknown applicability (i.e. in a key property such as ablatability) for which some may yield the desired properties, it seems that when one or more are found to work, patentable inventions will have been created.

The above arguments apply to the two pending independent claims (i.e. claims 1 and 6). As the remaining claims depend from either claim 1 or claim 6 and as these base claims are not anticipated by, or made obvious by, any combination of the references of record, it is believed that these dependent claims are allowable.

In view of the above remarks and the remarks presented previously, the application is believed to be in condition for allowance and reconsideration and withdrawal of the rejections and passage to allowance is earnestly solicited. If any questions should arise concerning this application, or if it would otherwise be useful to discuss this application, please do not hesitate to contact the undersigned by phone.

Microfabrica Inc.  
7911 Haskell Avenue  
Van Nuys, CA 91406  
Ph: (818) 786-3322, ext. 105  
Fx: (818) 997-3659

Respectfully submitted,



Dennis R. Smalley  
Reg. No. 35,364